

REMARKS

Claims 1, 4-9 and 17-22 are pending. Claims 1 and 17 have been amended. Claims 18-22 have been added. Support for the new claims and the claim changes can be found in the original disclosure, and therefore no new matter has been added. Claims 1, 17 and 18 are in independent form.

In the final Office Action dated April 7, 2006, Claims 1 and 5-9 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,946,073 (*Miwa '073*), and Claim 4 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miwa '073* in view of U.S. Patent No. 6,602,192 (*Miwa '192*).

Without conceding the propriety of the rejections, independent Claims 1 and 17 have been amended. Applicant submits that the independent claims are allowable over the cited art for at least the following reasons.

Independent Claim 1 recites, *inter alia*, (1) comparing means for comparing an intraocular pressure obtained by calculating means with a predetermined limit, (2) wherein control means gives a warning if the intraocular pressure obtained by the calculating means exceeds the predetermined limit.

Independent Claim 17 recites, *inter alia*, (1) control means for controlling a measuring operation of a noncontact tonometer so as to measure right and left eyes sequentially a predetermined number of times, respectively, and (2) comparing means for comparing an intraocular pressure obtained by calculating means with a predetermined limit, (3) wherein control means stops the measuring operation after completion of the predetermined number of measurements of the eyes under measurement if the intraocular pressure obtained by the

calculating means exceeds the predetermined limit.

Independent Claim 18 recites, *inter alia*, (1) a control unit adapted to control a movement of a measuring unit to sequentially measure an intraocular pressure of a second eye after measuring an intraocular pressure of a first eye, (2) wherein the control unit terminates a measuring operation without causing the measuring unit to move to measure the intraocular pressure of the second eye if the measured intraocular pressure of the first eye exceeds a predetermined limit.

By virtue of the invention as claimed in independent Claim 18, a fully automatic system in which measurements are sequentially performed for both eyes may be provided. The problem of an operator's forgetting to perform confirmation remeasurements may be avoided, and the time required for performing the confirmation remeasurements may be reduced

Applicant submits that, for the reasons set forth below, the cited art fails to teach or suggest at least the above-noted features recited in the independent claims.

Miwa '073 relates to a non-contact type tonometer. The *Miwa '073* device is designed to adjust the amount of pressure of compressed air blown on an examinee's eye, in accordance with the intraocular pressure of the eye. Different eyes have different intraocular pressures. In the case of an eye having a low intraocular pressure only a small amount of pressure is necessary to deform the cornea, while in the case of an eye having a high intraocular pressure a large amount of pressure is necessary to deform the cornea. Hence, it is desirable to blow air at a pressure appropriate to the intraocular pressure of the particular eye being examined, to avoid discomfort to the examinee and to ensure accurate measurement of an eye's

intraocular pressure.

In order to blow air at the appropriate pressure, *Miwa '073* sets an amount (ΔP or P2) of the air blowing pressure based on a start time of corneal deformation of the eye being examined. This start time is correlated with the intraocular pressure of the eye being examined. Therefore, an amount of pressure of the blown air that is appropriate to the eye's particular intraocular pressure is set.

(It is be noted that ΔP equals the difference between P2 and P1, so that setting ΔP is the effectively the same thing as setting P2.)

In operation of the *Miwa '073* device, control circuit 20 continuously or intermittently receives a signal from pressure sensor 12 indicating the amount of pressure of the air being blown toward the eye. When that pressure becomes equal to P2, control circuit 20 causes drive circuit 23 to stop compression and blowing of the air toward the eye. At this point in time (q2), control circuit 20 obtains the intraocular pressure of the eye.

Miwa '073 is not understood to teach or suggest the above-noted features recited in independent Claim 1 for at least the following reasons.

(1) Regarding the comparing means for comparing an intraocular pressure obtained by calculating means with a predetermined limit, recited in Claim 1, Applicant understands that the *Miwa '073* device (control circuit 20) may compare the pressure of the compressed air being blown toward the eye with P, but that *Miwa '073* does not teach or suggest comparing an intraocular pressure of an eye (calculated by calculating means on the basis of detection by corneal deformation detection means) with a predetermined limit. It is noted that in *Miwa '073* the control circuit 20 measures the pressure of the compressed air being blown toward

the eye using pressure sensor 12. ΔP is set based on a start time of corneal deformation of the eye being examined. At time q_2 (where the pressure of the compressed air being blown toward the eye equals $P_2 (= P_1 + \Delta P)$), the control circuit 20 obtains the intraocular pressure on the basis of the peak signal at q_2 . The obtained intraocular pressure is not then compared with a predetermined limit.

(2) Regarding the “wherein” clause of Claim 1, since *Miwa '073* does not suggest comparing the obtained intraocular pressure with a predetermined limit, *a fortiori* that document does not suggest giving a warning if the intraocular pressure obtained by the calculating means exceeds a predetermined limit.

In addition, Applicant submits that *Miwa '073* does not teach or suggest the “wherein” clause of Claim 1 for at least the following other reasons.

The Office Action (page 3) states that *Miwa '073* provides “a control means capable of giving a ‘warning’ in the form of a display (36), wherein comparison data may be viewed and thus provide a warning.” Applicant notes that monitor 36 is mentioned at col. 3, line 45, and col. 4, lines 23 and 27 of *Miwa '073*. As discussed thereat, when the examinee’s eye is illuminated by the infrared rays emitted from infrared light source 30, the image of the eye is formed on a CCD camera and displayed on monitor 36. Alignment information is displayed on monitor 36, and the operator uses the monitor 36 to perform alignment.

However, Applicant submits that *Miwa '073* cannot be deemed to give a warning, as recited in Claim 1. Even if monitor 36 could, for example, show the corneal deformation of the eye under examination, nothing in *Miwa '073* suggests that it gives a warning if the intraocular pressure of the eye exceeds a predetermined limit.

Even if the eye is displayed on monitor 36 at such time as the intraocular pressure of the eye exceeds a predetermined limit, the operator does not necessarily know, by looking at the display, whether the intraocular pressure of the eye exceeds the predetermined limit, even if the operator sees corneal deformation. Since the device does not inform the operator of anything at such time as the intraocular pressure of the eye exceeds the predetermined limit, the device cannot be said to give a warning if the intraocular pressure of the eye exceeds the predetermined limit.

More generally, Applicant understands the Office Action to be saying that the mere continual display of the eye constitutes (giving) a warning. However, a continual display would not serve to warn an operator, insofar as the display is continual. To be sure, it may be argued that the conditions of the eye being examined change over time as seen on the monitor. However, not all such changes represent states of the eye requiring a warning. Therefore, if every such change is deemed to constitute a “warning,” then the term “warning” is not being used in its normal sense and becomes devoid of meaning. On the other hand, if only certain of the changes are deemed to constitute a warning, then it is noted that the *Miwa '073* device does not inform the operator which changes constitute a warning and which do not; the operator would have to look at the monitor and determine on his own which changes constitute a warning. In that case, it could not be said that the *Miwa '073* device gives a warning to the operator.

Neither *Miwa '073* nor *Miwa '192*, whether taken singly or in combination (even assuming, for the sake of argument, that such combination were permissible), is understood to teach or suggest the above-noted features recited in independent Claim 17 for at least the following reasons.

(1) Regarding the control means for controlling a measuring operation of a noncontact tonometer so as to measure right and left eyes sequentially a predetermined number of times, respectively, recited in Claim 17, Applicant submits that nothing in *Miwa '073* or *Miwa '192* mentions an operation of measuring right and left eyes sequentially a predetermined number of times, respectively. Nothing in either of those documents is understood to teach or suggest the control means recited in Claim 17.

Further, Applicant notes that the Office Action does not cite anything in the prior art as teaching the control means recited in Claim 17; rather, the Office Action fails to address this element of Claim 17. However, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. . . . ‘All words in a claim must be considered in judging the patentability of that claim against the prior art’.” M.P.E.P. 2143.03. Accordingly, it is submitted that a *prima facie* rejection of Claim 17 has not been established.

(2) Regarding the comparing means for comparing an intraocular pressure obtained by calculating means with a predetermined limit, recited in Claim 17, the same arguments against *Miwa '073* as presented above with respect to Claim 1 (item (1)) apply to the comparing means recited in Claim 17. Nothing in *Miwa '192* is understood to remedy the deficiencies of *Miwa '073* in this regard.

(3) Regarding the “wherein” clause of Claim 17, it is noted that this clause includes aspects of the control means (“completion of the predetermined number of measurements of the eyes under measurement”) and the comparing means (“if the intraocular pressure obtained by the calculating means exceeds the predetermined limit”) of Claim 17.

Since, as discussed above in items (1) and (2), neither *Miwa '073* nor *Miwa '192* teaches or suggests either the control means or the comparing means of Claim 17, *a fortiori* they do not teach or suggest the “wherein” clause of Claim 17.

Neither *Miwa '073* nor *Miwa '192*, whether taken singly or in combination (even assuming, for the sake of argument, that such combination were permissible), is understood to teach or suggest the above-noted features recited in independent Claim 18 for at least the following reasons.

(1) Regarding the control unit adapted to control a movement of a measuring unit to sequentially measure an intraocular pressure of a second eye after measuring an intraocular pressure of a first eye, recited in Claim 18, Applicant submits that nothing in *Miwa '073* or *Miwa '192* mentions sequentially measuring an intraocular pressure of a second eye after measuring an intraocular pressure of a first eye. Nothing in either of those documents is understood to teach or suggest the control unit recited in Claim 18.

(2) Regarding the “wherein” clause of Claim 18, nothing in *Miwa '073* or *Miwa '192* is understood to teach or suggest controlling a noncontact tonometer to take action if a measured intraocular pressure of an eye exceeds a predetermined limit since, as discussed above with respect to Claim 1 (item (1)) and Claim 17 (item (2)), neither *Miwa '073* nor *Miwa '192* is seen to teach or suggest comparing the intraocular pressure of an eye with a predetermined limit.

Further, the “wherein” clause of Claim 18 includes aspects of the control unit (“without causing the measuring unit to move to measure the intraocular pressure of the second eye if the measured intraocular pressure of the first eye . . .”) of Claim 18. Since, as discussed

above in item (1), neither *Miwa '073* nor *Miwa '192* teaches or suggests the control unit of Claim 18, *a fortiori* they do not teach or suggest the “wherein” clause of Claim 18.

Since the cited art does not contain all of the elements of any of the independent claims, those claims are believed allowable over the cited art.

A review of the other art of record has failed to reveal anything which, in Applicant’s opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. These claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration or reconsideration, as the case may be, of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our Washington office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Douglas W. Pinsky', is written over a horizontal line.

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